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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/414,547	10/08/1999	TOKIMORI TOMITA	122.1046-D/G	3462

21171 7590 07/13/2007

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EXAMINER
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KARMIS, STEFANOS

ART UNIT	PAPER NUMBER
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3691

MAIL DATE	DELIVERY MODE
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07/13/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/414,547

Applicant(s)

TOMITA ET AL.

Examiner

Stefano Karmis

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 97, 98 and 100 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 97, 98 and 100 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

1. The following communication is in response to Applicant's amendment filed 19 April 2007.

### *Status of Claims*

2. Claims 1-77, 79-81, 85 and 90-93 are cancelled. Claims 78, 82-84, 86-89, 94-96 and 99 are withdrawn. Claim 100 is newly added. Therefore claims 97, 98 and 100 are currently pending.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 97, 98 and 100 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al. (hereinafter Schultz) U.S. Patent 5,056,019 in view of Nichtberger et al. (hereinafter Nichtberger) U.S. Patent 4,882,675.

Regarding claims 97, 98 and 100, Shultz teaches a method for managing points issued according to transactions under identification of a customer in a system connected to a terminal via a communication link, comprising;

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Identifying said customer according to customer identification information obtained from said terminal (column 9, lines 25-38; Examiner notes that the customer is identified by using their bar-coded identification code to be scanned by the in-store computer);

Issuing points according to said transactions under said identification (column 6, lines 5-12; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer);

Managing said points of said customer by calculating a balance point of said customer according to transactions performed by said customer (column 6, lines 5-12; Examiner notes that the manufacturer awards the consumer with points for each purchase of a particular products and that a gift is earned when a particular number of points is attained by the customer and column 10, lines 20-28; Examiner notes that the central management system determines the consumer's earned rewards (page 10, paragraph 20-28).

Schultz further teaches that the in-store computer comprises a databank for storing a plurality of files including customer files containing information related to consumers participating in frequent shopper program and reward files containing information related to the purchase reward offers (column 9, lines 47-53). It would be inherent to one of ordinary skill in the art that if the in-store computer system had access to the frequent shopper program and reward files that the customer would be able to obtain the reward balance and any reward certificates prior to the transaction. Even if one could argue that this is not inherent Nichtberger teaches a paperless system for distributing, redeeming and clearing merchandise coupons in which a customer presents his special card before the checkout process begins and the in-store

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computer unit receives the customer's coupons from the CDR and applies the coupons to items as they are being purchased (column 17, lines 30-61). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Schultz to include having the customer apply coupons as items are being purchased as taught by Nichtberger because it allows the customer to take advantage of coupons/rewards when items are being purchased rather than having to make another trip back to the store or having to remember to bring the physical coupon/reward. There is sufficient motivation combine the teachings of Schultz with Nichtberger because the reward certificates taught by Schultz act as earned coupons that can be applied for a discount or free gift. Schultz teaches that the reward certificate can be a voucher to be redeemed at the store for credit towards product purchases and is therefore applied similarly to the coupons taught by Nichtberger.

### *Response to Arguments*

5. Applicant's arguments with respect to claims 97, 98 and 100 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO**

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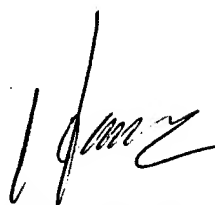
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
Stefano Karmis  
09 July 2007



HANI M. KAZIMI  
PRIMARY EXAMINER